

REMARKS

This Response is in reply to the office action mailed January 30, 2006 (hereinafter referred to as the "Office Action"). Claims 1-5, 7-8, 10-24 and 26-32 were pending. Claims 2, 3, 5, 10, 11, 13, 17, 19, 21, 22 and 24 were withdrawn subject to a restriction requirement.

Claims 27 and 30 have been amended herein. Claims 1-5, 7-8, 10-24 and 26-32 remain pending for consideration.

Reconsideration of the application is respectfully requested in view of the following responsive remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

In the Office Action, the following actions were taken:

(1) Claims 27, 28, 30 and 31 were rejected under 35 U.S.C. § 102(e) and 35 U.S.C. § 102(a) as being anticipated by Lee (U.S. . 20030025321 A1).

(2) Claims 1, 4, 7, 8, 12, 14-16, 18, 20, 23, 26, 29 and 32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee in view of Smith (EP 0884195 A1).

It is respectfully submitted that the presently pending claims be examined and allowed.

Rejections Under 35 U.S.C. § 102

The Examiner has rejected claims 27, 28, 30 and 31 under 35 U.S.C. § 102(e) and 35 U.S.C. § 102(a) as being anticipated by Lee. Before discussing the rejection, it is thought proper to briefly state what is required to sustain such a rejection. It is well settled that "[a] claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987). In order to establish anticipation under 35 U.S.C. 102, all elements of the claim must be found in a single reference. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986), *cert. denied* 107 S.Ct. 1606 (1987).

In particular, as pointed out by the court in *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1981), *cert denied*, 469 U.S. 851 (1984), "anticipation requires that each and every element of the claimed invention be disclosed in a prior art reference." "The identical invention must be shown in as complete detail as is contained in the...claim." *Richardson v. Suzuki Motor Co.* 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

Applicants respectfully submit that each and every element of independent claims 27 and 30 is not present in Lee. Independent claims 27 and 30 have each been amended to more specifically claim that the printing information comprises data related to, but not duplicative of, content of the printed image applied to the print medium. In other words, at least a portion of the printing information must be different than the content of the printed image. Lee, on the other hand, is primarily about verifying authenticity or recording additional information that is protected from view, etc. Lee sets forth two embodiments in paragraph [0021] where the magnetic image is either different or duplicated. However, when it is different, there is no teaching that the encoded information is still related to the printed image. As described in Applicants' previous response, the data related to content of the printed image can include such information as the names of people or objects in the image, locations of people or objects in the image, font types, authorship information, date/time, etc. This information is related to the content of the printed image, but is not the printed image itself. This amendment clarifies this distinction by specifically requiring information other than duplicative information. Support for this amendment can be found throughout the specification, particularly exemplified in embodiments where the content of the encoded information is related to, but not duplicative of the content of the printed image, e.g., names of people or objects in the image, locations of people or objects in the image, font types, authorship information, date/time, etc. Accordingly, Applicants respectfully request that the rejections under 35 U.S.C. § 102 be withdrawn.

Rejections Under 35 U.S.C. § 103

The Examiner has also rejected claims 1, 4, 7, 8, 12, 14-16, 18, 20, 23, 26, 29 and 32 under 35 U.S.C. § 103(a) as being unpatentable over Lee in view of Smith. It is noted that affidavits under 37 C.F.R. 1.131 are provided as Exhibit 1, and relevant portions of Disclosure No. 200309257, which was written, witnessed, and submitted to HP Legal prior to February 6, 2003 are provided as Exhibit 2. It is noted that the dates and other information that is not relevant to the rejected claims has been redacted from Exhibit 2. Further, it is noted that the information found in Exhibit 2 is merely exemplary of the information recorded prior to February 6, 2003.

As Exhibit 1 and Exhibit 2 establish a prior date of invention than the publication date of Lee (February 6, 2003), Lee is not available as a reference for consideration under 35 U.S.C. 102(a)/103, and thus, Lee is only proper for use as a reference under 35 U.S.C. 102(e)/103.

35 U.S.C. 103(c)(1) states the following:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Because Lee is only available as prior art under 35 U.S.C. 102(e), and because the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person, i.e. Hewlett-Packard, the rejection set forth by the Examiner falls under 35 U.S.C. 103(c). Thus, withdrawal of the rejection under 35 U.S.C. 103(a) is respectfully requested.

In view of the foregoing, it is Applicant's position that independent claims 1, 4, 7, 8, 12, 14-16, 18, 20, 23, and 26-32 present allowable subject matter and allowance thereof is respectfully requested.

Further, all claims that had previously been withdrawn which related to the election of species requirement are believed to now be also allowable, as all independent claims are generic and are in allowable condition.


Reconsideration of the election of species requirement is also requested.

If any impediment to the allowance of these claims remains after consideration of the above remarks, and such impediment could be removed during a telephone interview, the Examiner is invited to telephone W. Bradley Haymond (Registration No. 35,186) at (541) 715-0159 so that such issues may be resolved as expeditiously as possible.

Please charge any additional fees except for Issue Fee or credit any overpayment to Deposit Account No. 08-2025

Dated this 1st day of May, 2006.

Respectfully submitted,



Gary P. Oakeson
Attorney for Applicant
Registration No. 44,266

Of:

THORPE NORTH & WESTERN, LLP
8180 South 700 East, Suite 200
Sandy, Utah 84070
(801) 566-6633

On Behalf Of:

HEWLETT-PACKARD COMPANY
1000 NE Circle Blvd., m/s 422B
Corvallis, OR 97330-4239
(541) 715-0159